



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/781,741 | 02/20/2004 | Jay Steinmetz | BAR-002-USA-P | 3612 |

27955 7590 05/04/2005

TOWNSEND & BANTA
c/o PORTFOLIO IP
PO BOX 52050
MINNEAPOLIS, MN 55402

EXAMINER

LE, THIEN MINH

ART UNIT PAPER NUMBER

2876

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/781,741 | STEINMETZ ET AL. | |
| | Examiner | Art Unit | |
| | Thien M. Le | 2876 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-10 is/are allowed.
- 6) ☒ Claim(s) 1-3, 11-15, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 16-18 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claims 1-20 are presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 11, 13, 14-15, and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Brook et al. (herein after referred to as Brook – 6,170,746).

Brook discloses a "portable scanning and printing system 20 includes a display 28 that is controlled to display prompts to the user to enter particular information so as to lead the user through a drug tracking operation in order to prevent the user from forgetting to enter information that is necessary to track a drug. The portable scanning and printing device 20 also includes a barcode printer 30 that is preferably a label printer. In the embodiment shown in FIG. 1, the printer portion 30 of the portable scanning and printing system 20 is a labeler that includes a label applicator 31 for applying labels 29 after they have been printed. The portable scanning and printing system 20 includes a processing unit 32 with one or more microprocessors for controlling the various input and output devices and for controlling the collection of data in the memory 34. In particular, the processing unit 32 collects data in the memory 34 by selectively associating input information received from two or more of the input means 22, 24 and 26. Such selective association of data in the memory 34 allows the processing unit to transmit and/or print selected portions of the associated data. Therefore, the portable scanning and printing system is an intelligent system and not merely an input and/or output device for the host system 10. In the preferred embodiment, the portable scanning and printing device has a handle 36 and a trigger 38 mounted on the handle so as to actuate the barcode scanner 22 and/or printer portion 30 of the system 20 in accordance with the software of the processing unit 32. In this embodiment, the barcode scanner 22 and printer 30 are contained within a housing 39 forming a single integrated unit that is portable." (also see figures 1-2 of Brook).

Regarding claim 1, as can be seen, Brook discloses a handheld housing 20 comprising a bar code reader 22, a bar code printer 40 and a bar code label applicator 31 and thus would embrace all limitation set forth in this claim. It is noted that though Brook does not specifically mention the term "adhesive", the examiner is of the view that the adhesive bar code label backing is considered inherent.

Regarding claim 11, see the discussions above regarding claim 1. Further, Brooks discloses the use of his system for tracking drugs, "including narcotics, at hospitals, clinics, pharmacies, etc. The system includes a P.C. based server 10 having a personal computer (P.C.) 12 or the like with associated memory 13, a display 14, a keyboard 15 and/or mouse. The P.C. 12 is coupled to a local area network (LAN) 18 that includes the capability of wireless communication. One example of a suitable local area network 18 is a token ring although other types of LANs can be used as well. A radio frequency access point 19 on the local area network allows the P.C. based server 10 to communicate i.e. transmit and receive, wireless communications with the portable barcode scanning and printing system 20. Whereas, the P.C. based server 10 with wireless communication capability forming a host system maintains drug tracking records in its associated memory, the portable barcode scanning and printing system 20 allows drug tracking data to be collected, verified and recorded with minimal input from the user so as to increase the speed and accuracy of the drug tracking operation." As can be seen, Brook discloses the claimed invention.

Regarding claim 13, see figure 2 of Brook.

Regarding claim 14, see the discussions regarding claims 1-2. Further, figure 2 of Brook shows a computer 12 having a recorded database which would embrace all limitations set forth in this claim.

Regarding claim 15, see figure 2 for the wireless LAN network.

Regarding claims 19-20, see the discussions regarding claims 1 and 2. Further, Brook discloses the system and method for tracking drugs which thus inherently comprising the steps of scanning barcode on drug packages, bottles, pills, etc. for identification and condition information as discussed in claims 1 and 2; and thus would embrace all limitations set forth in this claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2-3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Brook et al. (herein after referred to as Brook – 6,170,746; cited above) in view of Patel et al. (Patent Publication No. 2003/0080189 A1, herein after referred to as Patel).

Regarding claim 2, see the discussions regarding claim 1. The claim differs in calling for a hybrid scanner and imaging device. However, this claimed limitation is not new. Reference to Patel is cited as evidence showing a hybrid digital camera and a bar code reader. Specifically, figures 9A-9C schematically illustrates a hybrid picture/video camera and 1-D barcode reader, or hybrid system 800. Referring to FIG. 9A, Patel discloses that the hybrid system 800 advantageously provides optimized 1-D barcode reading and 2-D digital image capture. A housing 802 encloses the interior components of the system 800 and holds the optics in place relative to the electronics. A PC board 804 is mounted to the housing 802, similar to the way the PC board 4 of FIGS. 1 and 3 is mounted to the frame 2. In this sense, the housing 802 may include

Art Unit: 2876

the same frame 2 of FIG. 1 modified (i.e., expanded) to include the 2D image capture components of the hybrid system of FIG. 9A.

It would have been obvious to implement a hybrid digital camera and a bar code reader as taught by Patel in the system as taught by Brook. The modification allows the system to read both 1D and 2D bar codes which thus effectively extend the applications of Brook's system.

Regarding claim 3, see the discussions regarding claims 1-2. Specifically, Brooks shows in figure 2 a wireless housing 20 which communicates information to a remote host computer 10 through a wireless communication link; and thus would embrace all limitations set forth in this claim.

Regarding claim 12, see the discussions regarding claims 1, 2, and 11. Further, Brook discloses the system and method for tracking drugs which thus inherently comprising the steps of scanning barcode on drug packages, bottles, pills, etc. for identification and condition information as discussed in claims 1 and 2; and thus would embrace all limitations set forth in this claim.

Allowable Subject Matter

Claims 4-10 are allowed.

Claims 16-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art disclose various combined barcode scanning, printing and applying systems. However, the prior art fails to disclose a hybrid barcode scanner and package/carton sealer system having a hand-held housing, a frame, a wireless scanning/imaging device, a carton sealer, and having the functions and characteristics as recited in claim 4.

The prior art also fails to disclose a hybrid system including a bar code scanner, and one of the tape dispenser, stapler, glue gun, as recited collectively in claims 16-18.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (571) 272-2396. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2876

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Le, Thien Minh
Primary Examiner
Art Unit 2876
April 28, 2005